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D-1147R1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:)
 Jay Paul Drummond, et al.)
) Art Unit 3624
Serial No.: 09/966,909)
)
Confirm. No.: 5701)
)
Filed: September 27, 2001) Primary Examiner
) Alain L. Bashore
For: AUTOMATED BANKING)
) MACHINE SYSTEM AND
) METHOD)

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Appellants request review of the rejections in the above-identified application (as presented in the Office Action dated June 7, 2006). No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal.

The review is requested for the reason that the 35 U.S.C. § 102(b) and 35 U.S.C. 103(a) rejections are not legally valid. The Office has failed to establish that all of the elements, relationships, and steps recited in the rejected claims are disclosed or suggested by the applied art. In addition, the nonstatutory double patenting rejections are not legally valid because the Office has failed to establish that all of the elements, relationships, and steps recited in the rejected claims are disclosed or suggested by claims of the referenced patents.

The Office has not established anticipation and/or a *prima facie* case of obviousness

Claims 1, 4, 6, and 18 were rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Joao, et al., U.S. Publication No. 2001/0051920 ("Joao").

Joao is directed to a system that automatically notifies users by telephone, pager, etc., that a transaction is being carried out with one of their accounts (e.g. credit card). The user may then authorize or cancel the transaction (Figures 3A-3C). With respect to claim 1, the Action references Figure 10 and paragraphs [0257], [0246], [0259], and [0053] of Joao to support the rejections. However, neither these, nor any other portions of Joao, discloses or suggests all of the features relationships and steps recited in claims 1, 4, 8, and 18.

For example, Joao does not disclose or suggest steps (a) and (b) of Applicants' claim 1. In step (a) an automated banking machine receives at least one first wireless communication signal from a portable wireless device. In step (b) the automated banking machine sends at least one first network communication signal corresponding to the at least one first wireless communication signal received by the banking machine, to at least one server in operative connection with the banking machine through a wide area network.

These steps correspond to an automated banking machine such as an ATM that is capable of enabling wireless communication devices to access servers on the Internet through wireless communication with the ATM. Joao is not directed to such a system. Nowhere does Joao disclose or suggest an automated banking machine capable of carrying out Applicants' recited steps (a) and (b).

For example, referenced paragraph [0257] of Joao discusses a central processing computer (303) that may be linked with various communication devices (e.g. phone 307, pager 313) through

a wired or wireless link (Figure 10). Referenced paragraph [0246] indicates that Joao may include an electronic cash transaction device (302) which is a terminal or other device used by an operator in performing transactions involving electronic cash. Referenced paragraph [0259] refers to Figure 11, and lists the various devices that are a part of the electronic cash transaction device (302) (e.g. CPU 302A, transmitter 302G, receiver 302H, etc.). Referenced paragraph [0053] indicates that Joao may be used in connection with the Internet.

These portions of Joao do not disclose or suggest an automated banking machine that is capable of carrying out steps (a) and (b) of claim 1. Further the Action does not explain how these cited paragraphs correspond to the Applicants' recited steps. The Office apparently regards Joao's communication devices (e.g. phone 307, and pager 313) as corresponding to the recited "portable wireless device." However, the Action does not state which features of Joao allegedly correspond to Applicants' recited automated banking machine and recited server. Thus Appellants have been forced to speculate that the Office regards the cash transaction device (302) as corresponding to an automated banking machine, and regards the central processing computer (303) as corresponding to a server.

However, regardless of whether the communication device, the electronic cash transaction device, and the central precessing computer of Joao could correspond respectively to a portable wireless device, an automated banking machine, and a server, the referenced portions of Joao still do not disclose or suggest that the system of Joao carries out steps (a) and (b) as specifically recited in claim 1.

Nowhere do the Action's referenced portions or any other portion of Joao, disclose or suggest that Joao's electronic cash transaction device (or any other device/terminal 2, 102, 202, etc.) both receives a wireless communication signal from a communication device (e.g. wireless

phone, pager) and then operates to send a network communication signal corresponding to the wireless communication signal, to Joao's central processing computer.

Joao does not disclose or suggest all of the recited features, relationships, and steps recited in Applicants' claim 1. In addition, Applicants' claims 2-17 recite at least the same and/or corresponding steps, features and/or relationships as claim 1. It follows that the Office has not established anticipation or *prima facie* obviousness with respect to all of these claims. Therefore the rejections of claims 2-17 are improper and should be withdrawn.

Nowhere in the referenced portions of Joao or anywhere else, does Joao disclose or suggest at least steps (c) and (d) of claim 18. Nowhere does Joao disclose or suggest Applicants' recited steps of determining with the automated banking machine that a portable wireless device is permitted to access a public wide area network, and responsive thereto, providing with the automated banking machine, the portable wireless device with access to the public wide area network. The Office has also not established anticipation or *prima facie* obviousness with respect to claim 18. It follows that the rejections of claim 18 and claims 19-20 which depend therefrom, should also be withdrawn.

**The Office Has Not Legally Supported the
Nonstatutory Obviousness-Type Double Patenting Rejections of Claims 1, 6, and 18**

Claims 1 and 18 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 5, 13-17, 18, and 25-27, of U.S. Patent No. 6,702,181. In addition, claims 1, 6, and 18 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6, 15, 19, 20, and 21 of U.S. Patent No. 6,796,490. Also, claims 1 and 18 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 15, 17, and 21 of U.S. Patent No. 7,040,533.

To support nonstatutory obviousness-type double patenting rejections the Office bears the burden of showing: (A) the differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and (B) reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is an obvious variation of the invention defined in a claim in the patent. MPEP § 804 (II)(B)(1).

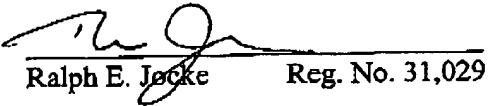
There are numerous patentably significant differences between the claims in the present application and the claims in the referenced patents. The Action only compares the single element of "signals" with the elements of "messages" and/or "transmitted financial customer account number." The Action has not established that all of the other features, relationships and steps recited in at least one claim of the present application, are disclosed or suggested by features in one claim of each of the referenced patents. For example where are steps (a)-(d) of claims 1, 6, and 18, disclosed or suggested by features recited in one claim in each of the referenced patents? The Office has failed to establish that all of the elements, relationships, and steps recited in any claim of the application are obvious in view of any claim in each of the referenced patents. It follows that the nonstatutory obviousness-type double patenting rejections of claims 1, 6, and 18 should be withdrawn.

Conclusion

Appellants respectfully submit that all the pending claims are allowable.

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Respectfully submitted,


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